

### **Remarks**

The following remarks and the above amendments are submitted to address all issues in this case, and to put this case in condition for allowance. The claims are amended solely to better define the subject matter of the instant invention. The subject matter of the new claims are supported by the specification as originally filed and add no new matter. After the above amendment, application claims 1-18, 20-43 and 45-48 are pending in the application. Application claims 1, 27, 28, 29, 30, 31, 32, 33, 34, 35, 40, 41, 43, 45 and 46 are independent.

Applicants have studied the Office Action Mailed November 1, 2006 and have the following remarks.

### **Double Patenting**

Without admission as to the correctness of the double patenting rejection in light of United States Patent 5,937,860, Applicant includes herewith a Terminal Disclaimer which moots the Examiner's double patenting rejection.

### **35 USC §112**

The Examiner rejected claims 1-26, 28-33, and 45 as being indefinite. Without admission as to the correctness of the Examiner's rejection, claims 1, 28, 29, 30, 31, 32, 33 and 45 have been amended to recite the component of the pliable posterior base providing antecedent basis for later use of the term posterior base. Further, claims 7, 31, 32, and 45 have been amended to recite an at least one additional lumen in the distal end in addition to the distal lumen to clarify which lumen is being referred to at which point.

### **35 USC §102 and §103**

The Examiner had rejected claims 1, 2, 8-14, 17, 20-26, 30, 31, 33, 35, 37, 39, 40, 43, and 44 as anticipated by Brain '879 (US 5,355,879) and claims 34, and 41-42 as anticipated by Pagan (6,240,922). The Examiner further rejected claims 3-6, 18, 19, 27 and 36 as obvious in light of the combination of Brain '879 in view of Brain '880 (US 5,682,880), claims 15, 16, 28, 29, and 32 as obvious over the combination of Brain '879 in view of Pagan, and claim 38 as obvious over the combination of Brain '879 in view of Brain '388 (US 4,995,388). Applicant respectfully traverses these rejections.

#### Pagan

Applicant first traverses on the grounds that Pagan does not constitute prior art to the present application. Applicants believe that at least the current claims 15, 16, 28, 29, 32, 34 and 41-42 are fully supported under 35 USC §112 by the original parent application Serial No.: 08/843,631 filed April 10, 1997 (Now US Patent 5,937,860) and are therefore entitled to an effective filing date of April 10, 1997. As that date is prior to the March 11, 1998 US filing date of Pagan used for purposes of 35 USC §102(e) (see MPEP 706.02(a)) Pagan is not believed to constitute prior art.

Applicant notes that with regards to claims 16, 41 and 42 the Examiner effectively admits that they are clearly supported under §112 by the original parent application by citing that original application in the double patenting rejection discussed above.

The above referenced claims do not stand rejected except in light of Pagan alone, or in combination with Pagan. Since Pagan does not constitute prior art to these claims, these claims

are believed to be allowable as no *prima facie* case of anticipation or obviousness has been provided.

#### Brain '879

Applicant first asserts that Brain '879 does not provide for a recessed front portion of the positioning shield as shown in the specification and provided in independent claims 1, 27, 28, 29, 30, 31, and 32, as amended, and new independent claim 46. The front portion of the Brain '879 positioning shield is clearly shown in the figures as being straight across (planar) as opposed to the device of the present application and claims which has a recessed front portion (biplanar). While the backplate 13 of Brain '879 does extend from the back of the shield portion, it does not do so at the front portion of the shield and does not provide a recessed front portion of the shield.

Further, the device of Brain '879 does not include a distal end of a respiratory tube passing through the peripheral portion of the positioning shield as discussed in independent claims 1, 27, 28, 29, 39, 31, 32, 33, 35, and 45, as amended, and new independent claim 46. The distal end of the respiratory tube is clearly shown to be separate from the ring 42 of the Brain '879 device and, as is clearly shown in FIG. 3 of Brain '879, does not pass through it.

With regards to independent claims 43, 45, and 46 as well as dependent claims 21, 23, 24, 47 and 48 the Examiner appears to be misreading the claims. The claims provide that the distal lumen has two different diameters (it's generally "keyhole" shaped), not that the respiratory tube has two different lumens of different diameter. This shape can be seen, for example, in FIG. 6 of the present application.

As stated in the claims and in the specification, the respiratory tube has (at least) two different lumens. A proximal end lumen and a distal lumen. While claims 20 and 21 provide for

relative diameters of the distal lumen compared to the proximal end lumen, claims 21, 23, 24, 43, 45, 46, 47, and 48 provide for relative diameters between different portions of the distal lumen. Claim 21, as amended, best illustrates the difference as it provides for a distal lumen with two different diameters, each of which is less than the diameter of the proximal end lumen.

Based on the above, as Brain '879 lacks a number of elements of the present independent claims, it cannot anticipate them or render them obvious.

#### Brain '879 in combination with Brain '880 and Brain '388

The Examiner solely used Brain '880 and Brain '388 in combination with the Brain '879 to show obviousness of various dependent claims. As shown above, the Brain '879 lacks multiple elements of each independent claim and Applicant asserts that neither Brain '880 or Brain '388 makes up for these deficiencies as they also fail to show the missing elements.

The claims are therefore believed to be non-obvious in light of any combination of these references.

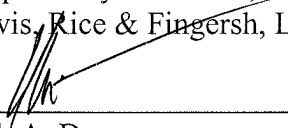
#### **Conclusion**

In light of the above, Applicant respectfully requests entrance of the above amendment and allowance of all pending claims so that this case can pass on to issue. As a final point, it is believed no fees are due in conjunction with this filing; however, the Commissioner is authorized to credit any overpayment or charge any deficiencies necessary for entering this amendment, including any claims fees and/or extension fees to/from our **Deposit Account No. 50-0975**.

If any questions remain, Applicant respectfully requests a telephone call to the below-signed attorney at (314) 444-7783.

Respectfully submitted,  
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Dated: January 31, 2007



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